

REMARKS

This Response is in response to the Final Office Action dated January 2, 2008. In the Office Action, claims 1, 2, 5-17 and 20-28 were rejected under 35 USC §103. Claims 1, 2, 5-17 and 20-28 are believed allowable, with claims 1, 6 and 22 being independent claims.

FINAL REJECTION AS PREMATURE:

In the non-final Office Action was mailed on July 2, 2007, claim 1 was rejected under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 6,804,684 ("Stubler") in view of U.S. Patent No. 6,043,819 ("LeBurn"). OA 7/2/07, pp. 5.

Furthermore, claim 15 was rejected over Stubler in view of LeBurn, and in further view of U.S. Patent No. ("Lipson"). OA 7/2/07, pp. 14. Specifically, the Office Action argued, "However Lipson teaches the use of models for each annotation or for joint annotations (col. 2, lines 56-59; col. 13, line 2-col. 14, line 18)."

On October 2, 2007, the Applicants filed an Amendment and Response to Office Action dated July 2, 2007. In the amendment, claim 1 was not amended, and claim 15 was amended as follows:

The method of claim ~~2~~ 13, wherein the models are based on nearest neighbor voting or variants, parametric or statistical models, expert systems, rule-based systems, or hybrid techniques.

Subsequently, the Final Office Action mailed on January 2, 2008 rejected claims 1 and 15 under 35 U.S.C. §103. In the Response to Arguments section of the Final Office Action, the Examiner presents, for the first time, the American Heritage College dictionary definition of the term "ambiguous". FOA 1/2/08, pp. 16. The Examiner argues that, based in part on the American Heritage College dictionary definition, claim 1 is considered unpatentable. FOA 1/2/08, pp. 17.

With respect to claim 15, the Examiner cited column 16, lines 11-15 and column 8, lines 53-60 of Lipson in the Response to Arguments section of the Final Office Action. FOA 1/2/08, pp. 19. These passages were never mentioned in the July 2, 2007 Office Action.

No information disclosure statements were submitted after the non-final Office Action mailed on July 2, 2007.

According to 37 C.F.R. 1.113, final rejections can only be made on the second or any subsequent examination or consideration by the examiner. Moreover, MPEP § 706.07(a) states "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

A new ground of rejection is created when an examiner designates a new "particular part relied on" or relies on a "different portion" of a reference. In re Wiechert, 370 F.2d 927, 933, 152 USPQ 247, 251-52 (CCPA 1967) ("An applicant's attention and response are naturally focused on that portion of the reference which is specifically pointed out by the examiner. . . . [W]hen a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-à-vis such portion of the reference").

In interpreting the term "new ground" in 37 C.F.R. § 1.196(b) the court stated, "Where the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence." In re DeBlauwe, 736 F.2d 699, 706 n. 9, 222 USPQ 191, 197 n.9 (Fed. Cir. 1984); In re Kronig, 539 F.2d 1300, 1302, 190 USPQ 425, 426 (CCPA 1976) ("the ultimate criterion of whether a rejection is considered 'new' in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection"). In re Eynde, 480 F.2d 1364, 1370-71, 178 USPQ 470, 474 (CCPA 1973) ("We do agree with appellants that where the board advances a position or rationale new to the proceedings . . . the appellant must be afforded an opportunity to respond to that position or rationale by the submission of contradicting evidence. This court so held in In re Moore, [444 F.2d 572, 170 USPQ 260 (CCPA 1971)], and we expressly reaffirm that view. The board's refusal to consider evidence which responds to such a new rationale is error.") MPEP § 1207.03(III) (deferring to the Kronig line of case law for the definition of the term "new ground"). Ex parte Teeple, Appeal No. 97-0943 at 9 (BPAI Feb. 17, 1998).

In the present case, the Final Office Action of January 2, 2008 advances new positions for rejecting claims 1 and 15. With respect to claim

1, the Final Office Action argues for the first time that based in part on the American Heritage College dictionary definition, claim 1 is considered unpatentable. With respect to claim 15, the Final Office Action relies on newly cited column 16, lines 11-15 and column 8, lines 53-60 of Lipson as the basis for rejecting the claim. These new passages were not necessitated by the Applicants' amendment of the claim 15 since the claim limitations were not changed.

For the reasons set forth above, the Applicants respectfully submit the Final Office Action of January 2, 2008 is premature and the finality of this action should be withdrawn. The Applicants have not been provided with an opportunity to fully respond to the new positions for rejecting claims 1 and 15. Moreover, the new positions for rejecting claims 1 and 15 were neither necessitated by the Applicants' amendment of the claims nor based on information submitted in an information disclosure statement.

CONCLUSION

It is respectfully submitted that this case is in condition for allowance and such action is respectfully requested. If any points remain at issue that the Examiner feels could best be resolved by a telephone interview, the Examiner is urged to contact the attorney below.

No fee is believed due with this Amendment, however, should such a fee be required please charge Deposit Account 50-0510 the required fee. Should any extensions of time be required, please consider this a petition thereof and charge Deposit Account 50-0510 the required fee.

Dated: October 2, 2007

Respectfully submitted,

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